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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATRIN REISINGER

Appeal 2009-007401
Application 10/797,494
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A. FISCHETTI, Administrative Patent Judges.

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 (2002) of the Examiner's final decision rejecting claims 1 to 14. We have jurisdiction over the appeal under 35 U.S.C. § 6(b) (2002).

We AFFIRM.

BACKGROUND

Appellant's invention is directed to an apparatus for automatic product code entry into a mail processing device (Spec. 1).

Claim 1 is illustrative:

1. A mail-processing device comprising:
 - a programmable memory having a table stored therein containing a plurality of product codes;
 - a program memory containing an operating program to generate print data for a franking imprint to be printed on a mail item;
 - a working memory having mail-item-related data values stored therein;
 - a keyboard having a plurality of operating elements allowing manual entry of said mail-item-related data values for said mail item into said working memory;
 - a microprocessor in communication with said programmable memory, said program memory, said program memory, said working memory, and said keyboard;
 - said programmable memory, said working memory and said microprocessor, in combination, being programmable by said operating program to set an operating mode for automatic product code entry; and
 - said microprocessor being programmed in said operating mode to evaluate said mail-item-related data values stored in said working memory and to automatically select an applicable product code from among said plurality of product codes stored in said table stored in said programmable memory, and to generate print data for a franking imprint for said mail item that includes said applicable product code.

The Examiner relies on the following prior art references as evidence of unpatentability:

Uno	US 5,535,127	Jul. 9, 1996
Guenther	US 5,852,813	Dec. 22, 1998

Microsoft® TechNet, *Memory*,
<http://technet2.microsoft.com/WindowsServer/en/library/7da85c6a-1e0a-439e-be35-eb795dce29ec1033.mspx?pf=true> (last visited Apr. 5, 2007) (hereinafter “Microsoft Memory”).

USPS, *Minutes of the Mailer’s Tech. Adv. Comm.*, 2-13 (Dec. 1997) (hereinafter “USPS Minutes”).

Appellant appeals the following rejections:

1. Claims 1 to 10, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Uno in view of Guenther and USPS Minutes.
2. Claims 11 and 13 under 35 U.S.C. § 103(a) as unpatentable over Uno in view of Guenther, USPS Minutes, and Official Notice.

ISSUES

Did the Examiner err in rejecting claims 1 to 14 because the prior art does not teach how a product code could be entered into a franking machine?

Did the Examiner err in rejecting claims 1 to 14 because Uno is based on a Japanese application whose filing date of July 16, 1993 is much too early for the subject matter disclosed in the reference to have any applicability to entering product codes and because Uno does not disclose creating a printed indicia?

FACTUAL FINDINGS

We adopt all of the Examiner's findings as our own. (Ans. 3 to 9).

ANALYSIS

The Appellant's argument that the Examiner err in rejecting claims 1 to 14 because the prior art does not teach how a product code could be entered into a franking machine is unpersuasive. Guenther discloses a method of insertion of sub-image data for producing an overall pixel image for a franking stamp and that the sub-image data can be coded. Guenther also discloses that this sub-image data can be code for the mail carrier. As Guenther discloses that code may be used in the franking process, we agree with the Examiner that it would have been obvious to a person of ordinary skill in the art to incorporate the teachings of a franking device of Guenther into the Uno device. We further agree with the Examiner that as Guenther already discloses using postal codes in a franking machine, the automatic entry of product codes would be no different than the entry of any other code in Uno or Guenther. In this regard, the Appellant has not argued or directed our attention to a section of the Specification that teaches that product codes are different in format, characteristics, or formats from other postal codes.

The Appellant's argument that the Examiner erred in rejecting claims 1 to 14 because Uno is based on a Japanese application whose filing date of July 16, 1993 is much too early for the subject matter disclosed in the reference to have any applicability to entering product codes is unpersuasive. It is not relevant to the obviousness determination in this case that the Uno

reference was filed at a time when product codes did not exist. What matters is what a person of ordinary skill in the art would have found obvious at the time of the present invention.

The Appellant's argument that the Examiner erred in the rejection because Uno does not disclose creating a printed indicia is also not persuasive. Uno is not cited for teaching printed indicia but rather Guenther is cited for generating print data for a franking imprint. An applicant cannot show non-obviousness by attacking references individually where, as here, the rejections are based on a combination of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

We find the Appellant's argument that the claims on appeal are patentable because they demonstrate a long standing problem with no solution unpersuasive. This argument appears to implicate the doctrine of long felt need. Evidence of long felt need must show that the problem solved by appellant's invention was known but not solved prior to the invention. *See Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1325 (Fed. Cir. 1999). To show failure of others, the evidence must establish that others skilled in the art tried and failed to find a solution for the problem solved by the appellant. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983).

In the instant case, Appellant argues that despite a decade of considering the product code, it is still not required by the USPS as of today. However, this is not evidence that there is a “problem” in using product codes. Appellant has not established that the reason product codes are not

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used today is because there is a problem in using the codes. Also, the Appellant has not established that others skilled in the art tried and failed to find a way to use product codes.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Uno in view of Guenther and USPS Minutes. We will also sustain this rejection as it is directed to claims 2 to 10, 12, and 14 because the Appellant has not argued the separate patentability of these claims.

We will sustain the rejection of claims 11 and 13 under 35 U.S.C. § 103(a) as unpatentable over Uno in view of Guenther, USPS Minutes, and Official Notice because the Appellant has not separately addressed this rejection but rather relied on the arguments made in response to the preceding rejection.

DECISION

We AFFIRM the Examiner's rejections under 35 U.S.C. § 103(a).

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2007).

AFFIRMED

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